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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,708	03/16/2004	Hiroshi Gotoh	R2184.0306/P306	1766
24998	7590	08/20/2007	EXAMINER	
DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			SANDERS, AARON J	
		ART UNIT	PAPER NUMBER	
		2168		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/800,708	GOTOH, HIROSHI	
	Examiner	Art Unit	
	Aaron Sanders	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 June 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-8 and 10 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-8 and 10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Specification

The title of the invention is objected to because the phrase “characteristic information of information recording medium” is incorrect. It appears that it should read “characteristic information of a information recording medium”.

Claim Objections

Claims 1, 2, 5, 7, and 10 are objected to because the limitation “the reproduced information” in the last limitation appears to lack antecedent basis in the claims. It appears to refer to “the client reproducing the other information recorded on the information recording medium” as in the second to last limitation, but this is not clear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5-8, and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 5-6, the server does not require any hardware, making it software *per se*.

As such, the instant claims are non-statutory.

As per claims 7-8 and 10, it appears that Applicant is trying to claim a manufacture. However, data manipulation is not a manufacture because there is no physical result produced from physical materials. As such, the instant claims are non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Takano, U.S. 2002/0082917.

As per claims 1-3, 5-8, and 10, Takano teaches:

1. A method of reproducing information in a client/server system, the method comprising the steps of (See e.g. Figs. 1 and 7):

providing an information recording medium containing characteristic information and having other information recorded thereon (See e.g. Fig. 11 where, see [0091], “The card 150 includes... management information storing unit 1103 recording rental management information” which comprises, see [0093], “More specifically, management information storing unit 1103 stores... management information (file name, title, due date, a reproduction key, storage location of content program data and the like)” where the claimed “characteristic information” is at least the referenced “file name” and “due date” and the claimed “other information” is the referenced “title”);

a client obtaining the characteristic information of the information recording medium (See Fig. 7, S701, “Read card management information” where, as shown in Fig. 1, the depicted “kiosk returning terminal” 110 is a client of a “kiosk management server” 170);

the client transmitting the characteristic information to a server (See e.g. Fig. 7, S702, “Transmit card management information and own terminal information to distribution center via kiosk management server” and Fig. 1);

the server obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A, S801, “Receive card management information” and S803, “Obtain/calculate and prepare user name, program title, usage period, information of additional fee”);

subsequently, the server transmitting information based on the usage information to the client (See e.g. Fig. 7, S703, “Receive information from distribution center via kiosk management server” and [0080], “In S805, a customized list is taken out, from preference ID data prepared based on the use history record of the user, from management data recording apparatus 408. In S806, the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110”); and

subsequently, the client reproducing the other information recorded on the information recording medium in accordance with the information based on the usage information (See e.g. Fig. 7, S704 and [0081], “Returning to FIG. 7, kiosk returning terminal 110 that has received in S703 the information transmitted in S806 displays the data on display unit 203 in S704”),

wherein the reproduced information is recorded on the information recording medium prior to said providing step (See e.g. Fig. 7, S704, “If necessary, display user name, program title, usage period, additional fee information, return confirmation button, additional fee payment button, customized list” where the referenced “title” was recorded on the recording medium prior

to Fig. 7, S701, see [0078], “First, in step S701, a card ID and management information in card 150 are read. Card management information stores a title, a rental due date and the like”).

2. A method of reproducing information using an information recording medium in a client/server system, the method comprising the steps of (See e.g. Figs. 1 and 7):

providing a second server containing second information (See e.g. Fig. 1, “Kiosk Management Server” 170);

subsequently, a client obtaining characteristic information of the information recording medium (See Fig. 7, S701, “Read card management information” where, as shown in Fig. 1, the depicted “kiosk returning terminal” 110 is a client of a “kiosk management server” 170);

the client transmitting the characteristic information to a first server (See e.g. Fig. 7, S702, “Transmit card management information and own terminal information to distribution center via kiosk management server” and Fig. 1, where the claimed “first server” is the referenced “Distribution Center” 101);

the first server obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A, S801, “Receive card management information” and S803, “Obtain/calculate and prepare user name, program title, usage period, information of additional fee”);

the first server transmitting first information based on the usage information to the second server (See e.g. Fig. 8 and [0080], “In S806, the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110” where the claimed “second server” is the referenced “kiosk management server” 170);

the second server transmitting said second information to the client in accordance with the first information based on the usage information (See e.g. Figs. 7-8 and [0080], “In S805, a customized list is taken out, from preference ID data prepared based on the use history record of the user, from management data recording apparatus 408. In S806, the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110”); and

the client reproducing the information based on the second information received from the second server (See e.g. Fig. 7, S704 and [0081], “Returning to FIG. 7, kiosk returning terminal 110 that has received in S703 the information transmitted in S806 displays the data on display unit 203 in S704”),

wherein the reproduced information is recorded on the information recording medium prior to said providing step (See e.g. [0093], “More specifically, management information storing unit 1103 stores... management information (file name, title, due date, a reproduction key, storage location of content program data and the like)” where the claimed “characteristic information” is at least the referenced “file name” and “due date” and the claimed “other information” is the referenced “title” and Fig. 7, S704, “If necessary, display user name, program title, usage period, additional fee information, return confirmation button, additional fee payment button, customized list” where the referenced “title” was recorded on the recording medium prior to Fig. 7, S701, see [0078], “First, in step S701, a card ID and management information in card 150 are read. Card management information stores a title, a rental due date and the like”).

3. The method as claimed in claim 2, wherein the client transmits the characteristic information to the first server via the second server (See e.g. Fig. 7, S702, “Transmit card

management information and own terminal information to distribution center via kiosk management server” where the claimed “first server” is the referenced “distribution center”).

4. (Cancelled)

5. A server providing information to a client using an information recording medium in response to a request of the client, the server comprising (See e.g. Fig. 1, “Electronic Content Programs Distributing and Returning Center Server” 101):

a first part configured to receive characteristic information of the information recording medium from the client (See e.g. Fig. 8A, S801, “Receive card management information”);

a second part configured to obtain usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A, S803, “Obtain/calculate and prepare user name, program title, usage period, information of additional fee”); and

a third part configured to transmit to the client information on authorization of reproduction of information from the information recording medium based on the usage information, to enable the reproduction of said information from the information recording medium (See e.g. [0085], “When the title to be rented is determined, card information is transmitted to electronic content programs distributing and returning center server 101 in S934, user authentication is performed, payment of rental fee takes place and, thereafter, through large capacity communication unit 301, data is read and recorded on the card 150 from the electronic content programs distributing and returning center server 101” and Fig. 1),

wherein the reproduced information is recorded on the information recording medium before the first part receives the characteristic information (See e.g. [0093], “More specifically, management information storing unit 1103 stores... management information (file name, title,

due date, a reproduction key, storage location of content program data and the like)" where the claimed "characteristic information" is at least the referenced "file name" and "due date" and the claimed "other information" is the referenced "title" and Fig. 7, S704, "If necessary, display user name, program title, usage period, additional fee information, return confirmation button, additional fee payment button, customized list" where the referenced "title" was recorded on the recording medium prior to Fig. 7, S701, see [0078], "First, in step S701, a card ID and management information in card 150 are read. Card management information stores a title, a rental due date and the like").

6. The server as claimed in claim 5, further comprising:

a fourth part configured to receive from the client the characteristic information of the information recording medium and notification requesting stoppage of usage of the characteristic information (See e.g. [0082], "When kiosk returning terminal 110 confirms whether content programs erasing process may be executed or not to electronic content programs distributing and returning center server 101 (via kiosk management server) in S720, electronic content programs distributing and returning center server 101 receives return confirmation information in S811. When return condition is satisfied, the center server instructs erasure of the content program in S812. In response, kiosk returning terminal 110 performs content program erasing process in S721. Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program" where the claimed "characteristic information" is the referenced "card management information" and the claimed "client" is the referenced "kiosk returning terminal");

a fifth part configured to delete the usage information of the information recording medium based on the characteristic information (See e.g. [0082], “Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program” where the claimed “characteristic information” is the referenced “card management information” and the claimed “usage information”, as shown in [0078], “Card management information stores a title, a rental due date and the like”, is included in the referenced “card management information”).

7. A computer-readable recording medium storing a program for causing a computer to execute a method, the method comprising the steps of (See e.g. Figs. 1 and 7):

- (a) receiving, based on a request of a client using an information recording medium, characteristic information of the information recording medium from the client (See e.g. Fig. 8A, S801, “Receive card management information”);
- (b) obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A, S803, “Obtain/calculate and prepare user name, program title, usage period, information of additional fee”); and
- (c) transmitting to the client information on authorization or reproduction of information from the information recording medium based on the usage information, and thereby enabling the reproduction of said information from the information recording medium (See e.g. [0085], “When the title to be rented is determined, card information is transmitted to electronic content programs distributing and returning center server 101 in S934, user authentication is performed, payment of rental fee takes place and, thereafter, through large capacity communication unit 301,

data is read and recorded on the card 150 from the electronic content programs distributing and returning center server 101" and Fig. 1),

wherein the reproduced information is recorded on the information recording medium before the characteristic information is received (See e.g. [0093], "More specifically, management information storing unit 1103 stores... management information (file name, title, due date, a reproduction key, storage location of content program data and the like)" where the claimed "characteristic information" is at least the referenced "file name" and "due date" and the claimed "other information" is the referenced "title" and Fig. 7, S704, "If necessary, display user name, program title, usage period, additional fee information, return confirmation button, additional fee payment button, customized list" where the referenced "title" was recorded on the recording medium prior to Fig. 7, S701, see [0078], "First, in step S701, a card ID and management information in card 150 are read. Card management information stores a title, a rental due date and the like").

8. The computer-readable recording medium as claimed in claim 7 wherein the method further comprises the steps of:

(d) receiving from the client the characteristic information of the information recording medium and notification requesting stoppage of usage of the characteristic information (See e.g. [0082], "When kiosk returning terminal 110 confirms whether content programs erasing process may be executed or not to electronic content programs distributing and returning center server 101 (via kiosk management server) in S720, electronic content programs distributing and returning center server 101 receives return confirmation information in S811. When return condition is satisfied, the center server instructs erasure of the content program in S812. In

response, kiosk returning terminal 110 performs content program erasing process in S721. Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program” where the claimed “characteristic information” is the referenced “card management information” and the claimed “client” is the referenced “kiosk returning terminal”); and

(e) deleting the usage information of the information recording medium based on the characteristic information (See e.g. [0082], “Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program” where the claimed “characteristic information” is the referenced “card management information” and the claimed “usage information”, as shown in [0078], “Card management information stores a title, a rental due date and the like”, is included in the referenced “card management information”).

9. (Canceled)

10. A computer-readable recording medium storing a program for causing a computer to execute a method, the method comprising the steps of (See e.g. Figs. 1 and 7):

providing an information recording medium having characteristic information and other information recorded thereon (See e.g. Fig. 11);

subsequently, obtaining the characteristic information of the information recording medium (See Fig. 7, S701, “Read card management information” where, as shown in Fig. 1, the depicted “kiosk returning terminal” 110 is a client of a “kiosk management server” 170);

requesting a server to provide information and transmitting the characteristic information to the server so that the server obtains usage information of the information recording medium

(See e.g. Fig. 7, S702, “Transmit card management information and own terminal information to distribution center via kiosk management server” and Fig. 1);

receiving information based on the usage information from the server (See e.g. Fig. 7, S703, “receive information from distribution center via kiosk management server”); and

subsequently, reproducing the other information recorded on the information recording medium in accordance with the information based on the usage information (See e.g. Fig. 7, S704 and [0081], “Returning to FIG. 7, kiosk returning terminal 110 that has received in S703 the information transmitted in S806 displays the data on display unit 203 in S704”),

wherein the reproduced information is recorded on the information recording medium before said providing step (See e.g. [0093], “More specifically, management information storing unit 1103 stores... management information (file name, title, due date, a reproduction key, storage location of content program data and the like)” where the claimed “characteristic information” is at least the referenced “file name” and “due date” and the claimed “other information” is the referenced “title” and Fig. 7, S704, “If necessary, display user name, program title, usage period, additional fee information, return confirmation button, additional fee payment button, customized list” where the referenced “title” was recorded on the recording medium prior to Fig. 7, S701, see [0078], “First, in step S701, a card ID and management information in card 150 are read. Card management information stores a title, a rental due date and the like”).

Response to Arguments

As per Applicant’s argument that the claims are statutory under 35 U.S.C. 101, the Examiner respectfully disagrees. Specifically, claims 5-6 are directed to a server, but do not

require any hardware, making it software *per se*. Claims 7-8 and 10 appear to be directed to a manufacture. However, data manipulation is not a manufacture because there is no physical result produced from physical materials. As such, the instant claims are non-statutory.

As per Applicant's argument that Takano does not teach that the reproduced information is recorded on the information recording medium before the method begins as in claims 1, 2, 5, 7, and 10, the Examiner respectfully disagrees. Specifically, the "management information" on the "card 150" of Takano contains both the claimed "characteristic information" and "other information". See e.g. Fig. 11 where, see [0091], "The card 150 includes... management information storing unit 1103 recording rental management information" which comprises, see [0093], "More specifically, management information storing unit 1103 stores... management information (file name, title, due date, a reproduction key, storage location of content program data and the like)" where the claimed "characteristic information" is at least the referenced "file name" and "due date" and the claimed "other information" is the referenced "title". Further, see Fig. 7, S704, "If necessary, display user name, program title, usage period, additional fee information, return confirmation button, additional fee payment button, customized list" where the referenced "title" was recorded on the recording medium prior to Fig. 7, S701, see [0078], "First, in step S701, a card ID and management information in card 150 are read. Card management information stores a title, a rental due date and the like".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Aaron Sanders whose telephone number is 571-270-1016. The Examiner can normally be reached on M-Th 8:00a-5:00p.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tim Vo can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2168

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AJS/
Aaron J. Sanders
Examiner
8 August 2007

SRP
8/9



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